

**REMARKS****Response to Claim Objections**

Claims 17 and 21 were objected to by the Examiner because of the following informalities: In claim 17, line 4, "at least one element" should read as "at least one encapsulating element" to provide proper antecedent basis for Claims 18 and 19. In Claim 21, line 8, "at least one element" should read as "at least one encapsulating element" to provide proper antecedent basis for Claims 22 and 23. Claims 17 and 21 have been amended to read "at least one encapsulating element" to provide proper antecedent basis for claims which depend on 17 and 21.

Claim 48 was objected to by the Examiner because of the following informalities: In line 5, "the opening" should read as "an opening" due to the lack of antecedent basis for "the opening". Claim 48 has been amended to read "an opening".

**Response to Double Patenting**

Claims 17-19, 21-23, 25, 48, and 51-53 were rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of U.S. Pat. No. 6,699,206 B2.

Claims 40-47 were rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of U.S. Pat. No. 6,699,206 B2.

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Claims 57 and 58 were rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of U.S. Pat. No. 6,699,206 B2.

A terminal disclaimer is included in addition to this response to overcome the Examiner's rejections based upon double patenting.

#### **Response to Claim Rejections Under 35 USC §102**

Claims 17-23, 25, 27, 30, 32, and 48-58 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Patterson et al. (U.S. Pat. No. 5,941,869). The claims as amended, however, call for encapsulating the specimen in its entirety. The Patterson patent does not teach or disclose encapsulating the specimen in its entirety before removal from the body. Patterson teaches the use of a filter or occlusion balloons to capture potential emboli. In view of the fact that this reference does not disclose all the features of the claimed invention, the reference cannot anticipate the the rejected claims.

#### **Response to Claim Rejections Under 35 USC §103**

Claims 24 and 59 were rejected by the Examiner under 35 U.S.C. §103(a) as unpatentable over Patterson et al. (U.S. Pat. No. 5,941,869) as applied to claims 23 and 57 above, and further in view of Kieturakis (U.S. Pat. No. 5,794,626). As discussed above Patterson does not disclose a device which encapsulates and removes a tissue specimen in its entirety. The Kieturakis patent fails to make up for the deficiency in the Patterson patent. Kieturakis discloses an auger member (354) which rotates to draw tissue into a bore in a sleeve, however, the auger member is used to facilitate drawing tissue into the bore sleeve for aspiration (Col 9, lines 6-10), rather than to completely

encompass the specimen for removal along with the device. The Kieturakis and Patterson references both fail to teach or disclose encapsulation and removal of the tissue specimen in its entirety from a patient's body.

#### **Response to Allowable Subject Matter**

The applicant notes with appreciation the Examiner's indication that Claims 28 and 33 are directed to patentable subject matter. Applicants believe that the claims from which claims 28 and 33 depend are allowable, there is no need to for these claims to be rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Canceling Unduly Limiting Claim Language**

Applicants have amended claims 17, 21, 30, 40 and 50-55 to delete unduly limiting language which required the tissue encapsulation to occur as the device or cutting element is rotated about the longitudinal axis of the device. The unduly limiting language is now the subject of new claims 60-69.

### Conclusions

The applicants believe that the pending claims are directed to patentable subject matter. Reconsideration and an early allowance of these claims are earnestly solicited.

Respectfully submitted,

By: 

Edward J. Lynch  
Registration No. 24,422  
Attorney for Applicants

DUANE MORRIS LLP  
One Market  
Spear Tower, Ste. 2000  
San Francisco, CA 94105  
Telephone: (415) 371-2200  
Facsimile: (415) 371-2201  
Direct Dial: (415) 371-2267